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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/032,692

12/27/2001

Peter Collinge

HR1.P04

7282

7590

04/02/2007

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EXAMINER

MCCORMICK EWOLDT, SUSAN BETH

ART UNIT

PAPER NUMBER

1661

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/032,692	Applicant(s) COLLINGE, PETER	
	Examiner S. B. McCormick-Ewoldt	Art Unit 1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In view of the Appeal Brief filed on January 11, 2007, PROSECUTION IS HEREBY REOPENED. The rejection of claim 1 is set forth below.

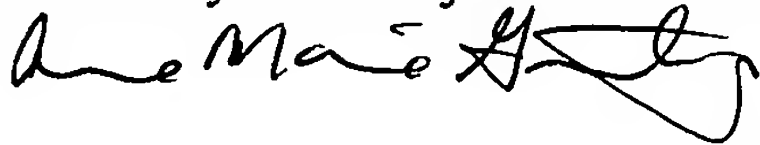
To avoid abandonment of the application, Appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then Appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

The finality of the rejection of the last Office action is withdrawn.



Claims Pending

Claim 1 is pending. Claim 1 is will be examined on the merits.

Drawings

The drawings have been approved by an official draftsman.

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163 (a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More specifically:

A. Appellant discloses on page 1, line 12, that the claimed tree was discovered as “a whole tree mutation” whereas Appellant discloses that “the sport” arose. Sport mutations are usually considered a “branch mutation.” Additionally, the recitation “block of trees of ‘Sciearly’ was propagated” is unclear as to what is encompassed. Does Appellant mean that the block of trees of ‘CJ07’ was propagated on MM106? Appellant should clarify what is meant by “block of trees....” and the “sport”. Clarification is needed.

B. Appellant failed to disclose additional information relative to the height and spread for the observed tree at a specified age and location of culture and/or amount of growth over a specified period of time. The recitations “Medium size” and “medium vigor” does not adequately

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describe the size or vigor of the observed tree. However, Appellant may disclose that the claimed variety was pruned to a particular size. Clarification is needed.

C. Appellant failed to disclose information regarding the size (length and width), average number (per square inch) and color of the lenticels of the branch and trunk. This information is fairly easy to acquire since lenticels are recognized year round.

D. Appellant failed to set forth the flower diameter, observed number of flowers per cluster and characteristic fragrance (if any).

E. Appellant failed to set forth information relative to pollination requirements of the observed tree. Is it self-fertile or requires a pollinator? Clarification is needed.

F. Appellant failed to disclose the eye adequately. The recitation "Size, medium" does not sufficiently describe the eye.

G. Appellant failed to disclose the known shipping and storage characteristics of the observed variety. For example, the number of days the fruit has been stored under specific conditions. However, Appellant describes the keeping qualities of the fruit as excellent, however, it is not clear what excellent means. This may be sufficiently described by indicating number of days, etc.

F. The fruit lenticel color should be set forth in the specification and size, if available. It is not clear what "small" is.

Note to Appellant that the USPTO does not make field comparisons or side-by-side comparisons of cultivars as other UPOV countries require. The USPTO requires measurements, as well as color, to distinguish similar varieties. The enclosed UPOV descriptor sheet may be useful to any future application, however the measurements should be quantified since the

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USPTO does not do field comparisons to distinguish varieties. A copy of the UPOV guidelines for apples is disclosed for Appellant's benefit.

The above listing may not be complete. Appellant should carefully review the disclosure and import into the disclosure any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

Response to Arguments

Appellant argues (brief, pages 9-10) that "At no time..... has an Appellant for a plant patent been required to provide an enabling description of the variety for which a plant patent protection is being sought." This is correct. At no point in the prosecution of this application has such a requirement been made by the Examiner. However, 35 U.S.C. 162 and 37 CFR 1.163(a) require that the description of the claimed plant be as complete as reasonably possible. This is the standard that is being applied.

Appellant argues (brief, page 10) the botanical description and illustrations included in a plant patent application assist in identifying the plant claimed but have no impact on the scope of the claim. This argument, while correct, is not persuasive because Appellant has not explained why this fact relieves him of the statutory obligation to provide a complete description of the claimed plant.

Appellant argues (brief, page 11) that a "reasonably complete description" of a claimed plant variety is limited to identification of the "novel, distinguishing and non-variable characteristics of a new plant variety, and ...commercially relevant features of the variety." This argument is not persuasive. 37 CFR 1.163(a) requires "as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents" (emphasis added). These are two distinct requirements. A limited disclosure which only describes the "distinguishing characteristics" of the claimed plant does not suffice. A disclosure of the plant which is "as full and complete...as possible" is also required.

Appellant argues (brief, page 11) that a highly detailed and exacting patent specification..... but it is not more useful in enforcing the rights of the patent owner. This

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argument is not directly relevant to the rejection. However, it is noted that Appellant's focus on the patent owner's rights overlooks the fact that the public is entitled to certain benefits in exchange for the grant of a U.S. patent. As stated by the Supreme Court, "the means adopted by Congress of promoting the progress of science and the arts is the limited grant of the patent monopoly in return for *the full disclosure of the patented invention* and its dedication to the public on the expiration of the patent (*Scott Paper Co. v. Marcalus Mfg. Co.*, 67 USPQ 193, 196, emphasis added). Appellant's reluctance to provide a complete disclosure of the claimed invention is contrary to the spirit and purpose of the patent system.

Appellant argues (brief, page 12) that many of the botanical characteristics of the claimed plant, for which the Examiner has required a detailed description, are variable. This argument is not persuasive. In biological systems, almost everything is variable. The Office recognizes that growing conditions influence plant morphology, yield and other characteristics. For this reason, Examiners typically request that the growing conditions and age of the observed plant be disclosed, to make the descriptions more meaningful. Describing the plant by using term such as "large" and "medium," without further elaboration, is vague and ambiguous. Furthermore, it is perfectly acceptable for morphological characteristics to be described as a range. Describing the leaf length as "8-10 cm" is more precise than "medium," for example, and is certainly more useful for comparing one plant with another. With regard to Appellant's continuing assertion that an "enabling description" is being required, the Examiner reiterates that no such requirement has been made. As disclosed in the above rejection, the USPTO does not make field comparisons or side-by-side comparisons of cultivars as other UPOV country requires. The USPTO requires measurements, as well as color, to distinguish similar varieties. However, these are descriptors Appellant may find useful for this and future applications. A copy of the UPOV guidelines for apples is disclosed for Appellant's benefit.

Appellant argues (brief, page 13) only general information regarding the bloom (for example) of the 'C J07' tree has been provided, because little or no attention is paid by those skilled in the art of commercial horticulture to the appearance of the flowers. Certainly more information would be appropriate if this was an ornamental variety, but it is not. This is not found persuasive because an apple rootstock still produces apples even if though it is not grown

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for that. They still need to be described in accordance with providing as complete a botanical description as is reasonable necessary.

Appellant argues (brief, page 14) that a detailed botanical description does not aid the USPTO in examining plant patent applications. This is not persuasive, and completely illogical, as a detailed botanical description **does** aid in distinguishing new plants from previously patented varieties as described above. As the list of issued plant patents grows, complete and precise descriptions are needed to aid in examining future plant patent applications. The distinguishing feature of the claimed plant appears to be the color of the fruit and the time of harvest. The less detail that is provided in describing the rest of the plant, the more difficult it will be to distinguish any future fruited sports of the 'CJ07' variety.

Appellant argues (brief, p. 14) that no matter how detailed the description of the plant, the Office cannot make a meaningful comparison with other plants. The Examiner recognizes the limitations inherent in comparing written descriptions rather than actual plants grown side-by-side under identical conditions. Nevertheless, it is clearly desirable to base a patentability determination on as much information as possible. The more information that is available to the Examiner, the greater the likelihood that the Examiner's determination will be correct.

Appellant argues (brief, page 15) that, under the *Imazio* decision, a description of a plant cannot anticipate a description of a second plant variety. This is not persuasive because the *Imazio* decision concerned infringement, not patentability. Thus, the fact that the accused plant in the *Imazio* case was found not to infringe the patent at issue (by virtue of its "independent creation") does not mean that it was *patentably distinct* from the patented plant. Appellant's position that no plant can anticipate another is clearly incorrect, especially in view of MPEP 1610, which provides a form paragraph for rejecting a claim under 35 U.S.C. 102 when the claimed plant is not patentably distinct from another variety known in the prior art.

[I]n order for the new variety to be distinct it must have characteristics clearly distinguishable from those of existing varieties....The characteristics that may distinguish a new variety would include, among others, those of habit; immunity from disease; resistance to cold, drought, heat, wind, or soil conditions; color of flower, leaf, fruit, or stems; flavor; productivity, including ever-bearing qualities in case of fruits; storage qualities; perfume; form; and ease of asexual reproduction. Within any one of the above or other classes of characteristics the differences which would suffice to make the variety a distinct variety, will necessarily be differences of degree. *Imazio Nursery Inc. v. Dania Greenhouses*, 36 USPQ2d 1673, 1677, quoting S. Rep. No. 315, 71st Cong., 2d Sess. 4 (1930).

Appellant argues (brief, pages 16) that the claimed plant has been distinguished from other varieties, citing *In re Greer*. This argument is not persuasive because *In re Greer* does not

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state that a reasonably complete description that distinguishes the new variety from its parents and from other known varieties is all that is needed to meet the requirements of 35 U.S.C. 162 and 37 CFR 1.163 that the specification must contain as full and complete a disclosure as possible of the plant.

Appellant does not understand that 37 CFR 1.163(a) requires “as full and complete a disclosure as possible” of 1) the plant and 2) the “distinguishing characteristics” of the plant. In *Greer*, the specification was deficient with regard to the second requirement, whereas the specification in the instant application is deficient with regard to the first requirement. Therefore the *Greer* decision has little bearing on the issue at hand.

Appellant argues (brief, page 16) that it is improper to require the specification to conform to terms selected by the Examiner. Appellant also argues the request by the Examiner for additional information is unsupported by specific reasons as to why such detail is necessary to a reasonably complete description. The Examiner has never required that the Appellant conform to terms for the specification. This argument is discussed above sufficiently with regards to the botanical description required by the Examiner.

Regarding Appellant’s statement of Table 1, it is noted to Appellant that each patent application was examined and decided on its own merits by the Examiner of record.

Claim Rejection

35 U.S.C. § 112, 1st and 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claim 1 is rejected under 35 U.S.C. 102(b) as the claimed plant as described and illustrated does not patentably distinguish over the plant forming the basis of United States Plant Patent Number 7956. For example, the over color of the fruit is Red Group 46B (i.e. the color designations are according to the Royal Horticultural Society Colour Chart) (see col. 4, lines 51-52). Appellant bears the burden of clearly and precisely describing the characteristics which define and distinguish the new variety (In re Greer 179 USPQ 301).

The application is not patentably distinct from the enclosed patent in that it is deemed identical to the to the cited patent because of an incomplete botanical characteristics are listed. As a result it is difficult to distinguish the new plant from the prior art. Appellant is advised that once the specification contains as full and complete a disclosure as possible of the plant, it may be sufficient to overcome this rejection.

Claim 1 is rejected under 35 U.S.C. 102(b) as the claimed plant as described and illustrated does not patentably distinguish over the plant forming the basis of United States Plant Patent Number 5584. For example, the fruit color is 46C to 46B and the flesh color is 11D (i.e. the color designations are according to the Royal Horticultural Society Colour Chart) (see col. 3, lines 1 and 20-22). Appellant bears the burden of clearly and precisely describing the characteristics which define and distinguish the new variety (In re Greer 179 USPQ 301).

The application is not patentably distinct from the enclosed patent in that it is deemed identical to the to the cited patent because of an incomplete botanical characteristics are listed. As a result it is difficult to distinguish the new plant from the prior art. Appellant is advised that once the specification contains as full and complete a disclosure as possible of the plant, it may be sufficient to overcome this rejection.

Summary

No claim is allowed.

Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick-Ewoldt whose telephone number is (571)

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272-0981. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiners' supervisor, Anne Marie Grunberg, can be reached at (571) 272-0975. The official fax number for the group is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sbme


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SUPERVISORY PATENT EXAMINER